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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/465,133	12/15/1999	ELISABETTA VEGETO	246/180	8491

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WONG CABELLO LUTSCH RUTHERFORD & BRUCCULERI, LLP  
20333 SH 249, SUITE 600  
HOUSTON, TX 77070

EXAMINER

QIAN, CELINE X

ART UNIT PAPER NUMBER

1636

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/465,133

Applicant(s)

VEGETO ET AL.

Examiner

Celine X Qian

Art Unit

1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 October 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 13 October 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): 112 2<sup>nd</sup> paragraph rejection to claims 168-176.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

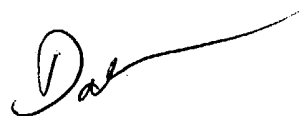
Claim(s) rejected: 144, 147-161, 163-168 and 170-192.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

Continuation of 2. NOTE

Continuation of 5. does NOT place the application in condition for allowance because: the proposed amendment does not overcome the written description rejection and scope of enablement of the record mailed on 10/13/04. The written description requirement is not overcome because the claimed genus of the progesterone receptor ligand binding domain comprises one or more alterations from 1-54 carboxyl terminal is not fully described in the instant specification. As discussed in the previous office action, the specification only describes two deletion mutants of the human progesterone receptor that have the function of reverse a ligand specificity of the receptor and confer activation by an antagonist to the unmutated receptor. Thus, the claimed invention only has written description support to these two species, not any mutant receptor having any type of alteration in 1-54 carboxyl terminal. In addition, the previous office action indicated that the enabled scope for the claimed invention is a) introducing into a wild type animal a construct encoding a progesterone receptor with at least 42 amino acid deletion from C-terminal, and another construct comprising a progesterone receptor responsive element linked to a report gene; b) administering a ligand that binds to said mutated receptor to said animal, wherein said transgenic non-human animal expresses a heterologous reporter gene and a mutated steroid receptor, wherein expression of said receptor regulates the expression of the reporter gene by binding to the promoter of said reporter gene. The amended claims do not have the limitation of expressing the reporter gene. In addition, the claimed mutant receptor has a broader scope than what is enabled by the instant specification (detailed reasons, see page 3-6 of the previous office action). Therefore, both rejection is maintained.



DAVE T. NGUYEN  
PRIMARY EXAMINER